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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,723	01/02/2002	Bjarne Roenfeldt Nielsen	5636.210-US	6089

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EXAMINER	
RAO, MANJUNATH N	
ART UNIT	**PAPER NUMBER**
1652	

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/038,723	NIELSEN ET AL.	
	Examiner	Art Unit	
	Manjunath N. Rao, Ph.D.	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *141-240 and 242-253* is/are pending in the application.

4a) Of the above claim(s) *144-240 and 242-253* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *141-143* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/351,814.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 141-240, 242-253 are currently pending and are present for examination. Claims 141-143 which reads on the elected species are now under consideration. Claims 144-240, 242-253 remain withdrawn from consideration as they are directed to non-elected subject matter.

Species Election

Applicant's election of a single species, i.e., position 402 in Paper filed on 10-24-03 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/351,814, filed on 7-12-1999.

Drawings

Drawings submitted in this application are accepted by the Examiner for examination purposes only.

Sequence Compliance

Applicant is required to comply with the sequence rules by inserting the sequence identification numbers of all sequences recited within the claims and/or specification. It is particularly noted that applicant fails to provide SEQ ID NO to nucleic acid sequences recited in the specification, for example, see page 42. See particularly 37 CFR 1.821(d).

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 141 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,352,851. This is a double patenting rejection. Examiner is aware that claim 1 of the above patent is directed to a variant of SEQ ID NO:2 or an amino acid sequence that is 60% identical to SEQ ID NO:2 as opposed to claim 141, wherein the claim is directed to a variant of SEQ ID NO:2 or an amino acid sequence that is 80% identical to SEQ ID NO:2. It should be noted that both claims are directed to the respective amino acid sequences in the alternative. Therefore, claim 141 of the instant application and claim 1 of the patent are identical with respect to the portion of claim directed to the variant of SEQ ID NO:2 and encompassing position 402.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 141-143, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,352,851. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim, because the examined claim is either anticipated by, or would have been obvious over the reference claim. See, e.g., *In re Berg*, 140 F.3d 1428,46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi* 759 F.2d 887,225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 141-143 of the instant application and claims 1-2 of the reference patent are both directed to variants of glucoamylase having an amino acid sequence SEQ ID NO:2 or a sequence that is at least 80%, 90% or 95% identical to SEQ ID NO:2 (SEQ ID NO:2 of the reference and the instant application are 100% identical) and comprising an alteration at an amino acid corresponding to position 402. The different % homologies of SEQ ID NO:2 claimed in the instant application are encompassed in the % homology (i.e., amino acid sequence 60% identical to SEQ ID NO:2) claimed in the reference patent. The portion of the

specification (and the claims) in the reference patent that supports the recited amino acid position on SEQ ID NO:2 and the % homology of SEQ ID NO:2 includes several embodiments (% homology of SEQ ID NO:2 and the amino acid position) that would anticipate the subject matter claimed in claims 141-143. Claims of the instant application listed above cannot be considered patentably distinct over claims 1-2 of the reference patent when there is specifically recited embodiment that would anticipate mainly claims 141-143 of the instant application. Alternatively, claims 141-143 cannot be considered patentably distinct over claims 1-2 of the reference patent when there is specifically disclosed embodiment in the reference patent that supports claims 1-2 of that patent and falls within the scope of claims 141-143 herein because it would have been obvious to one having ordinary skill in the art to modify claims 1-2 of the reference by selecting a specifically disclosed embodiment that supports those claims i.e., a variant of a parent glucoamylase with SEQ ID NO:2 or a sequence that is at least 80%, 90% or 95% identical to SEQ ID NO:2 comprising amino acid change at position 402. One of ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being a preferred embodiment within claims 1-2 of the reference patent.

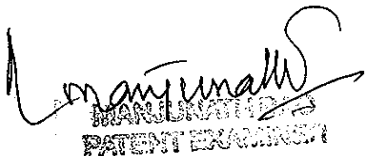
Conclusion

None of the claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath N. Rao, Ph.D. whose telephone number is 703-306-5681. The examiner can normally be reached on 7.30 a.m. to 4.00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0196.



Manjunath N. Rao
December 30, 2003